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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,511	07/10/2003	Bernd Misselwitz	SCH-1911	1752

23599 7590 11/30/2005

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1618

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,511

Applicant(s)

MISSELWITZ ET AL.

Examiner

D. L. Jones

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/15/05; 7/8/04; & 2/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 8-11, 16-29 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-15, 30-36 and 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 2/26/04 wherein claims 3, 8, 10-12, 20-22, 29, 30, 37, 44, and 45 were amended.

Note: Claims 1-50 are pending.

APPLICANT'S INVENTION

2. Applicant's invention is directed to perfluoroalkyl containing metal complexes.

RESPONSE TO APPLICANT'S ELECTIONS

3. Applicant's election with traverse of Group 19 (claims 1-7, 12-15, 30-36, and 45-50) filed 9/15/05 is acknowledged. The elected invention is directed to uses of perfluoroalkyl containing metal complexes of formula Ic wherein K is formula (IIc) on page 29 of the claims. In addition, Applicant's election of the species denoted MK13 in Table I on page 28 of the specification is acknowledged. Applicant traverses the restriction on the ground that the PTO has not established that it would pose an undue burden to examine the full scope of the application. This is found non-persuasive because the instant invention reads on a multitude of possible perfluoroalkyl containing metal complexes wherein K may be formulae II on page 4; formula III on page 5; formula IV on page 6; formula V on page 6; formula VI on page 7; formula VII on page 7; formula VIII on page 8; formula IX on page 8; formula X on page 9; formula XI on page 9; formula XII on page 10; formula XIII on page 10; formula Va on page 18; formula VIa on page 18; formula VIIa on page 18; formula VIIIa on page 19; the first structure in claim 19 on page 20; formula IIb on page 22; formula IIc on page 29; and

Art Unit: 1618

formula IId on page 39. Hence, search each individual K value in combination with a perfluoroalkyl containing metal complex would result in an undue burden since various classes and subclasses would have to be searched and the K values are structurally different. Therefore, the restriction requirement is still deemed proper and is therefore made FINAL.

WITHDRAWN CLAIMS

4. Claims 8-11, 16-29, and 37-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

DOUBLE PATENTING REJECTIONS

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

Art Unit: 1618

F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 51 of copending Application No. 10/857,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to imaging using a K of formula IIc and a perfluoroalkyl containing metal complex. The claims differ in that the claims of the instant invention are specifically directed to imaging thrombi wherein those of 10/857,877 are not limited to imaging thrombi. Thus, a skilled practitioner in the art would recognize that the invention of 10/857,877 encompasses that of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1618

101 REJECTIONS

7. Claims 1-7, 12-15, 30-36, and 45-50 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

112 REJECTIONS

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-7, 12-15, 30-36, and 45-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7, 12-15, 30-36, and 45-50 provide for the use of a perfluoroalkyl-containing metal complex, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 30, line 12: The claim is ambiguous because it is difficult to read some of the superscripts in the claim.

SPECIFICATION

10. The disclosure is objected to because of the following informalities: Applicant is respectfully requested to incorporate the continuing data into the first line of the specification. In addition, Applicant is requested to incorporate a 'Brief Description of the Drawings' heading and description of the figures into the specification.

Appropriate correction is required.

PRIORITY DOCUMENTS

11. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 7/10/02. It is noted, however, that applicant has not filed a certified copy of the German 10231799 application as required by 35 U.S.C. 119(b).

COMMENTS/NOTES

12. It should be noted that no prior art has been cited against the instant invention. However, it should be noted that the claims were examined as 'A method of using a perfluoroalkyl containing complex for imaging intravascular thrombi...' wherein the complex has the limitations set forth in elected Group 19.

Note: The claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious a method of imaging intravascular thrombi using a perfluoroalkyl-containing complex having the limitations of Group 19.


Art Unit: 1618

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617.

The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

November 28, 2005